

**REMARKS**

Claims 1-6 are canceled. Claims 7-12 are pending.

**Specification Objections**

The Examiner has objected to the previous amendment to the specification as “adding new matter” and notes that, “an incorporation by reference statement cannot be submitted after the filing date of an application.” Applicants’ disagree, the specification as amended does not incorporate new matter. The 12/10/10 amendment to the specification, which is objected to by the Examiner, is an explicit statement of the priority claim that was entered when the application was filed. MPEP §201.13 specifically states, “a claim under 37 CFR 1.55 for priority of a prior-filed foreign application that was present on the filing date of the U.S. application is considered an incorporation by reference of the prior-filed foreign priority application...applicants are encouraged to provide an explicit incorporation by reference statement” (emphasis added). See also MPEP §608.01(p). Therefore, the 12/10/10 amendment is simply an explicit statement of the incorporation by reference that resulted from the priority claim on the day the application was filed and *is not new matter*. Applicants’ respectfully request withdrawal of the objection to the specification.

**Claim Rejections – 35 USC § 102**

Claims 7-10 and 12 are rejected under 35 U.S.C 102(b) as being anticipated by US Patent 4,394,891 to Oshima.

For a rejection grounded in anticipation under 35 U.S.C. § 102 to be proper, every element and limitation recited in the rejected claim(s) must be found in the cited 35 U.S.C. § 102 reference. See MPEP § 2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Id.*, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). See also, *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994). The MPEP restricts the prior art that may be cited by an Examiner in making a 35 U.S.C. § 102(b) rejection to those where the “identical invention [is] shown in as complete detail as is contained in the ... [rejected] claim.” *Id.*, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The Examiner states that Oshima discloses, *inter alia*, “a spot type disc brake

comprising... a spring assembly 9 to adjust a clearance between the brake lining and the brake disc after brake application, which is detachably fastened in the spot type disc brake, wherein the brake lining 3 and the actuating device 8 are both located on a same side of the brake disc 1 as shown and wherein the spring assembly... comprises a spring clip 9c, 9d connected to the spring element and being detachably fastened at the brake lining by way of two spring arms 9a, 9b.” Applicants respectfully disagree.

Claim 7 has been amended to recited, “wherein the brake lining and the actuating device (5) are both located on a same side of the brake disc such that the spring assembly is supported on the brake lining (4) that interacts directly with the actuating device (5)”.

Oshima teaches a disc brake that has a spring 9 that is supported by both brake linings (Column 3, lines 17-34). Oshima does not teach a spring element that is supported by one of the brake linings, nor that the brake lining supporting the spring element is the one that interacts directly with the actuation device as recited by Applicants’s amended claim 7.

Further, Oshima does not teach that, “the brake lining and the actuating device (5) are both located on a same side of the brake disc,” and the spring element is “detachably fastened at the brake lining (4) by way of two spring arms (13, 23),” (emphasis added) as required by Applicants independent claim 7. Applicants recite only one brake lining in the claim language. Therefore, based upon proper application of antecedent basis to the language of claim 7 the brake lining that is “located on a same side of the brake disc” is the same brake lining to which the spring element is “detachably fastened.” Oshima teaches the spring 9 is detachably fastened to the brake lining that is on an opposing side of the brake disc from the brake actuator 8. Therefore, Oshima does not teach “the brake lining and the actuating device (5) are both located on a same side of the brake disc,” and the spring element is “detachably fastened at the brake lining (4)” as required by Applicants’ independent claim 7.

Thus, claims 7-10 and 12 are allowable over Oshima for at least these reasons. Withdrawal of the 35 U.S.C. § 102 rejections of these claims is respectfully requested.

### **Claim Rejections – 35 USC § 103**

Claim 11 is rejected under 35 U.S.C 103(a) as being unpatentable over Oshima in view of US Patent 2,711,801 to Super *et al.*

Obviousness is a question of law based on factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). See MPEP §2141. The Graham factual inquiries include (A)

determining the scope and content of the prior art; (B) ascertaining the differences between the claimed invention and the prior art; and (C) resolving the level of ordinary skill in the art. *Id.* “The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis.” *Id.*

A proper rejection under 35 U.S.C. §103(a) requires that, the Examiner must establish an “apparent reason” to modify the reference or to combine reference teachings. *KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). According to the United States Supreme Court, “[o]ften, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.” *KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 14.

Oshima fails to disclose, a spring element that is supported by one of the brake linings, and that the brake lining supporting the spring element is the one that interacts directly with the actuation device. Oshima further fails to disclose, “*the* brake lining and the actuating device (5) are both located on a same side of the brake disc” and the spring element is, “detachably fastened at *the* brake lining (4),” as required by Applicants’ claim 7, from which claim 11 depends. Super et al. fails to remedy this initial deficiency of Oshima and the Examiner has not provided a reason to modify the combined references to do so. Thus, claim 11 is allowable over Oshima in view of Super et al. for at least these reasons. Withdrawal of the 35 U.S.C. § 103(a) rejections of these claims is respectfully requested.

## New Claims

Applicants have added new claims 13-14, as set forth in the “Listing of the Claims” section, *infra* at 3-4. New claim 13 recites, “wherein the spring assembly is supported on the brake lining (4), which is located on the same side of the brake disc as the actuating device (5)” New claim 14 recites, “wherein the spring assembly is detachably secured at the brake lining (4), which interacts directly with the actuating device (5).” Oshima and Super et al. neither disclose nor suggest these features. No new matter is being introduced into the subject application through the proposed addition of claims 13-17, as the claims are properly supported by paragraph [0004] of the specification.

**CONCLUSION**

Accordingly, Applicant believes that the claims as amended overcome the raised objections and rejections and are in a condition for allowance.

Applicants do not believe any fees are due in connection with the filing of this Response. If, however, Applicants are in error and there are additional fees due, including any extension fees, please charge all such required fees to Deposit Account 50-2570.

Respectfully submitted,

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